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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/295,850 04/21/99 Y00

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EXAMINER

IM22/0109

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NEW YORK NY 10023

HALPERN, M

ART UNIT

PAPER NUMBER

1731

DATE MAILED:

01/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/295,850

Applicant(s)

YOO, GI YONG

Examiner

Mark Halpern

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/31/2000.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-7 is/are pending in the application.
- 4a) Of the above claim(s) 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

1) Acknowledgement is made of Amendment received 10/30/2000, Paper No. 4. Claims 1-3 are cancelled and new claims 4-7 are offered for consideration. The Amendment is in response to Office Action of 4/28/2000, Paper No. 3.

Election/Restrictions

2) Newly submitted claim 7 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claim 7 is directed to method for aiding smoking cessation, while the original claims are directed to tobacco substitute composition.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 7 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Specification

3) A substitute specification less the claims is required pursuant to 37 CFR 1.125(a) because of numerous changes made to the specification and the changes were not entered by the Office.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37

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CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 4) Claims 4-6, are rejected under 35 U.S.C. 103(a) as being unpatentable over Shin (KR 9007855B) in view of Webster's 3rd. New International Dictionary, Finberg (US 2,930,719) and Horimoto (US 4,620,554).

In regard to claim 4, Shin discloses a tobacco substitute composition comprising *Eucommia ulmoides*, licorice, honey and peppermint mixture (Shin, Abstract). It would have been obvious to adjust the percentage of *Eucommia ulmoides* in the composition in order to obtain desired taste of the composition. Licorice reads on claimed *Glycyrrhiza glabra* in view of definitions found in Webster (Webster, page 970, col. 1). The claim recites limitation of 1-10% of licorice in the composition, which is not specifically disclosed by Shin. Finberg teaches using licorice as flavourant in a casing

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material in a tobacco substitute at 4% (Finberg, col. 3, line 70). It would have been obvious to add the licorice to the tobacco substitute composition of Shin at 4% as taught by Finberg because such combination would accomplish the desired results of flavoring the composition. Shin also does not teach adding 1-10% of *Perilla frutescens*, also called Beefsteak according to Webster. Horimoto teaches using Beefsteak, Japanese mint, peppermint and vanilla interchangeably as flavorants in a smoking composition from 1-10% (Horimoto, col. 1, lines 53-55). It would have been obvious to combine Beefsteak and Japanese mint with the composition of Shin because the aseptic action and tasteful properties of Beefsteak (Horihito, col. 2, lines 10-20) and the refreshing feel and taste properties of Japanese mint, would provide further flavoring in the Shin tobacco substitute composition.

In regard to claim 5, Shin discloses glycerol. See Abstract.

In regard to claim 6, Shin discloses using peppermint (Abstract). Furthermore, Horimoto discloses using peppermint in combination with Beefsteak and Japanese mint within the claimed ranges (col. 2, list 1).

Response to Amendment

5) Applicant's arguments with respect to rejected claims 1-3 have been considered but are not persuasive.

In regard to argument that Shin does not by itself disclose a composition of the present invention, the prior art in combination with the other prior art cited, Webster, Finberg and Horimoto, presents a proper rejection under 35 U.S.C. 103(a).

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In regard to argument that prior art does not disclose that the composition can be used as a smoking cessation tool, it is not critical to establish what function the composition can be performing.

Conclusion

6) Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone number is 703-305-4522. The examiner can normally be reached on Mon-Thu, (8:30-6:00), and alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on 703-308-3837. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7718 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

MH

Mark Halpern
Examiner
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January 3, 2001

A handwritten signature in black ink, appearing to read "Peter Chin". The signature is fluid and cursive, with the first name "Peter" and last name "Chin" clearly distinguishable.

**PETER CHIN
PRIMARY EXAMINER**